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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/227,881	01/11/1999	THAI D. NGUYEN	07425.0057	7578

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ARNOLD & PORTER LLP  
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555 TWELFTH STREET, N.W.  
WASHINGTON, DC 20004-1206

EXAMINER

SCHULTZ, JAMES

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/227,881

Applicant(s)

NGUYEN ET AL.

Examiner

J. D. Schultz, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 145, 150, 154, 156, 161 and 165-174 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 145, 150, 154, 156, 161 and 165-174 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date 26 April 2005.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Status of Application/Amendment/Claims***

Applicant's response filed 27 May 2005 has been considered. Rejections and/or objections not reiterated from the previous office action mailed 19 November 2004 are hereby withdrawn. The following rejections and/or objections are either newly applied or are reiterated and are the only rejections and/or objections presently applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Interview***

It is noted that Applicants representative incorrectly indicates in their discussion of the interview that took place 26 April 2005 that the present application would pass to allowance should claims rejected under 35 U.S.C. § 102(b) were canceled and a terminal disclaimer filed. It was agreed to withdraw the restriction requirement and rejoin claims to the complement of SEQ ID NO: 34 that had not been examined. However, since these claims had not been previously examined, any alleged indication of allowability would have been premature, and it is maintained that such an indication was not provided.

***Election/Restrictions***

In the Official action mailed 19 November 2004, claims 145, 156, 167, and the subject matter of claims 145-154, 156-165, and 167-174 as drawn to complements or fragments of the complements of SEQ ID NO: 34 were withdrawn by original

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presentation as being directed to a non-elected invention. This restriction is hereby withdrawn.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 150, 154, 161, 165 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims above are dependent upon claims which are canceled.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

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directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 166-174 are rejected under 35 U.S.C. 102(a) as being anticipated by Nguyen *et al.* (J. Biol. Chem. 1998. 273(11) 6341-6350).

At the outset it is noted that the instant application claims CIP priority to U.S. Application Number 08/938,669, which claims CIP priority to U.S. Application Number 08/791,154. Priority for the instantly rejected claims 166-174 to these applications is denied, because SEQ ID NO: 34 is not disclosed in either of the priority documents. Although both documents disclose larger sequences that contain the sequence disclosed in SEQ ID NO: 34, there is no teaching in either application that would lead one of skill to the shorter, discrete sequence of SEQ ID NO: 34, and thus, because SEQ ID NO: 34 is the subject of the presently rejected claims, priority to the earlier filed documents is denied. The instant application is therefore accorded the filing date of the instant application, 11 January 1999.

The claimed invention is drawn to a substantially purified nucleic acid comprising the nucleotide sequence of SEQ ID NO: 34 or its complement, or fragments of said sequence that are between 15 and 250 nucleotides long, or to vectors or cells containing said sequence.

Nguyen *et al.* teaches a sequence comprising SEQ ID NO: 34 and its complement (as evidenced by its disclosure in a vector, which is double stranded), and vectors and cells containing said sequence. See figure 3. Furthermore, Nguyen discloses

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primers that hybridize to said sequence, which thus constitute fragments that are between 15 and 250 nucleotides long that are complementary to said sequence. See Genomic Structure Analysis section of Materials and Methods.

Claims 145 and 156 are rejected under 35 U.S.C. 102(b) and 102(e) as being anticipated by Weber *et al.* (U. S. Patent Number 5,582,979).

At the outset it is noted that priority is denied to earlier parents because, as noted above, SEQ ID NO: 34, the subject of the instant claims, first appears as a discrete sequence in the instant application. The instant application is therefore accorded the filing date of the instant application, 11 January 1999.

Claims 145 and 156 are drawn to nucleic acid fragments 15 to 250 nucleotides long of the complement of SEQ ID NO: 34, or to nucleotides 1 through 5271 of SEQ ID NO: 3, which is alleged by applicants to be identical to SEQ ID NO: 34.

Weber *et al.* teaches an oligonucleotide complementary to SEQ ID NO: 34 at nucleotides 4996 to 5023, which meets all the limitations of the instant claims.

### ***Conclusion***

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Douglas Schultz, Ph.D. whose telephone number is 571-272-0763. The examiner can normally be reached on 8:00-4:30 M-F. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached at 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

JD Schultz, PhD



**JAMES SCHULTZ**  
**PATENT EXAMINER**